

II. Claims 32-72 are, drawn to a composition for coating keratin fibres comprising, in a cosmetically acceptable medium, at least one wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, *and at least one compound chosen from dextrin esters of fatty acids and/or at least one filler having a BET specific surface area of greater than or equal to 100 m<sup>2</sup>/g* classified in class 424, subclass 70.1.

III. Claim 101 is drawn to a non-therapeutic cosmetic makeup or care process for keratin fibers comprising: applying to the fibers at least one composition comprising, in a cosmetically acceptable medium, at least one wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa classified in class 424, subclass 70.7.

IV. Claim 102 is drawn to a non-therapeutic cosmetic makeup or care process for the eye area comprising applying to at least one of the contour of the eye, the lower edge of the eye, the upper edge of the eye, and the eyelid, at least one composition comprising, in a cosmetically acceptable medium, at least one wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa classified in class 424, subclass 70.7.

V. Claim 103 is drawn to a non-therapeutic process for obtaining a uniform and/or smooth and/or separating makeup result on keratin fibers comprising applying to the fibers a composition comprising, in a cosmetically acceptable medium, at least one wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa classified in class 424, subclass 70.7.

VI. Claims 104-105 are drawn to an assembly (1) for packaging and applying a product for coating keratin fibres, comprising: i) a container (2) containing the composition according to Claim 1, and ii) means (12), for applying the composition to the fibres classified in class 132, subclass 1+.

Dec. 14, 2006, Office Action, at 2-3 (emphasis in original).

Applicants respectfully traverse the restriction requirement, as set forth above and on pages 2-6 of the Office Action. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, comprising claims 1-31 and 73-100.

In addition, the Examiner asserts that the present claims are “directed to the following patentably distinct species: belonging to wax[,]” which, according to the Examiner, “can be natural wax or synthetic wax or it can be compounds of formula I.” *Id.* at 6. The Examiner thus requires Applicants to elect a “single disclosed species belonging to wax.” *Id.* Applicants respectfully traverse this election requirement as set forth on page 6 of the Office Action. However, to be fully responsive, Applicants elect, with traverse, the “species” drawn to waxes of formula (I) as “belonging to wax.” The Examiner asks for “a listing of all claims readable” on the election of species. *Id.* at 6-7. Thus, Applicants note that while claim 21 specifically recites the elected species, all claims of the restrict Group, i.e., claims 1-31 and 73-100, are readable thereon.

The Examiner admits that “[i]nventions I and III-V are related as product and process of use,” and “[i]nventions VI and I are related as apparatus and product made.” *Id.* at 4. However, the Examiner asserts that the inventions are distinct because, with respect to Groups I and III-V, the Examiner asserts that “[i]n the instant case the process for using the product as claimed can be practiced with film forming polymer live PVP/VA.” *Id.* at 4. With respect to Groups VI and I, the Examiner asserts that “[i]n this case the product as claimed can be practiced with an assembly containing a container and the container containing the composition and the container containing [sic] curved brush for coating the keratin fibers.” *Id.* Applicants disagree.

Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P instructs the Examiner as follows:

If the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I-VI together would constitute a serious burden. Rather, the Examiner admits that various groups are related as: product and process of use (Groups I and III-V, see Dec. 14, 2006, Office Action, at 4), and apparatus and product made (Groups VI and I, see *id.*). The Examiner contends that the above related groups can also be distinct, but does not specify what serious burden will be placed on the Examiner if she were to proceed in examining the groups together, as required by M.P.E.P. § 803.

Further, Applicants respectfully submit that, at a minimum, examining the claims of Groups I and III-V together would not impose a serious burden. M.P.E.P. § 803 states that “a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification.” In contrast, the Examiner indicates that Groups I and III-V fall into the same “class 424, subclass 70.7.” *Id.* at 2-3.

Additionally, Applicants submit no serious burden would exist in light of the requirement of rejoinder. See M.P.E.P. § 821.04. Accordingly, it is unclear what burden is on the Examiner to examine at least the claims of Groups I and III-V together, and Applicants respectfully request withdrawal of the restriction requirement.

Moreover, Applicants respectfully traverse the election of species requirement, at least because the Examiner, similar to the Restriction Requirement, has failed to show that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species the Examiner must, inter alia, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species. M.P.E.P. § 803.02 (emphasis added). Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone how examination of all the species would impose a serious burden. It can hardly be said that the three alleged species (belonging to wax) are an “unreasonable” number. Thus, there is truly no burden on the Examiner to examine the defined species together.


If the Examiner chooses to maintain the election of species requirement, Applicants expect the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a “reasonable” number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. Accordingly, it is unclear what burden is on the Examiner to examine all claimed species together, and Applicants respectfully request withdrawal of the Restriction Requirement.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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